Supreme Court of the United States.

OCTOBER TERM, 1904.

HOWE SCALE COMPANY OF 1886 AND FAY-SHOLES COMPANY,
Defendants-Appellants,

v.

WYCKOFF, SEAMANS & BENEDICT,
Complainant-Appellee.

No. 130.

SUPPLEMENTAL BRIEF FOR COMPLAINANT-APPELLEE.

We avail ourselves of the permission granted at the argument to state shortly our position and what we conceive are the principal errors in the defendant's argument.

The complainants' position, which was endorsed by the courts below, is that in a case like this where a corporation begins a new business and selects a name under which to introduce itself and its products to the public the case is one where a person not of the name has adopted it as his business name and marked his goods with it, and is to be so treated even though one or more of its incorporators, stockholders, or officers may be of that name.

We submit that in this case all the arguments and au-

thorities which relate to the proposition that every man has a right to use his own name in his own business are wholly inapplicable, because it is the corporation-defendant and not any individuals connected with it that is carrying on the business under the name and marking its goods with it, and because before its adoption of the name it had no such name and took over no business or good will to which the name could be regarded as appurtenant.

The authorities in this country and in England are, without exception, perfectly harmonious and all to this effect. The question has been decided time and again by courts of last resort and there is not a single decision to be found in the books wherein it has been held that a corporation derives any right whatever to use a particular name from the mere fact that one of its incorporators and stockholders bears that name.

Say the Court of Appeals of New York:

> "The defendant derives no additional immunity from the fact that the name of Higgins in its corporate name was that of one or more of its incorporators or that Charles S. Higgins or anyone of that name might engage in the soap business under the family name, or that Charles S. Higgins and the other incorporators of the same name had consented to its use."
>
> Charles S. Higgins Co. *v.* Higgins Soap Co.,144 N. Y. 462.

Say the English Court of Appeal, referring to a similar situation:

> "The Valentine Extract Company, Limited, is not the name of any man."
>
> Valentine Meat Juice Co. *v.* Valentine Extract Co., Ltd., 17 R. P. C. 673.
>
> 83 L. Tms. 271.

Say the Court of Appeals for the First Circuit, Mr. Justice Gray sitting as a member of the court:

> "The authorities * * * touching the ordinary inherent right of every person to the honest use of his own surname" have not "been extended to corporations which have appropriated surnames."
>
> Le Page Co. *v.* Russia Cement Co., 51 Fed. 941–943.

Say the Court of Appeals for the Sixth Circuit, in a case to which the defendant directed particular attention at the argument:

> "The cases which enjoin corporations from the use of a particular name, even though the name be that of some one connected with it, are not uncommon. * * * But such cases are distinguishable. A corporate name is an artificial name, and is selected with an object, and may be changed, and a new one taken. The adoption of a particular name as a part of a corporation name, as in the Garrett case, may carry with it patent evidence of an intent to mislead and trade unfairly."
>
> Royal Baking Powder Co. *v.* Royal, 122 Fed. 337–345.

In a very carefully-considered opinion, where most of the authorities are reviewed, the rule was recently stated as follows:

> "Where the second comer is a corporation that has adopted such name as part of its corporate name, the case has been treated as one where a person not of that name has adopted it as his business name, and marked his goods with it, even though some or all of its incorporators, stockholders, or officers may be of that name. For in such case it is the corporation, and not the individuals connected with it, that is doing business in that name, and marking its

goods with it, and, before the adoption of the name by it, it had no such name."

Bissell Chilled Plow Works *v.* T. M. Bissell Plow Company, 121 Fed. 357–367.

Many other cases to the same effect are collected in our principal brief (p. 87 *et seq.*). There is, so far as we know, not a single authority to the contrary. The cases cited by the defendant are, none of them, cases where a corporation has attempted to take the name of an individual similar to a name long used by a rival in the same business without taking with it some business or good-will which the name had by usage come to indicate to the public. (See complainant's principal brief, p. 286 *et seq.*)

And the same distinction between the name of an individual and the name of a corporation is expressed in the decrees which have been formulated in all such cases.

For example, in the Valentine case, which perhaps, more than any other to be found in the books resembles the case at bar, the decree prohibited the corporation-defendant, Valentine Extract Company,

> "from carrying on business * * * under any name or title of which the name 'Valentine' or 'Valentine's' forms part, and from selling * * * any such preparation * * * under any name or description of which the name 'Valentine' or 'Valentine's' or 'Valtine' forms part."

The individual defendant, Charles Richard Valentine, on the other hand, was restrained from carrying on business or selling the article "without clearly distinguishing" his business or article from that of the plaintiffs.

Valentine Meat Juice Co. *v.* Valentine Extract Co., 17 R. P. C. 688.

In the case of an individual using his own name in his own business, the court may be powerless wholly to cor-

rect possible confusion, because perhaps it cannot take from the defendant his inherent right to use his name, and some injury may, therefore, be *damnum absque injuria*. But in the case of a corporation, there is no conceivable reason why any injury should not be wholly prevented, because the corporation has no inherent right to the name and the courts have, accordingly, not hesitated to prevent any possible confusion.

The decree in the present case is not more broad than that issued in the Valentine case, and is less broad than that issued in other cases where a defendant is using the name which embodies the good will of another *without right* (*e. g.*, Pinet *v.* Pinet, 15 R. P. C. 65). It is, in fact, as narrow as the form of decree which has been entered in cases where the defendant has used a particular name under a claim of *right of which he could not be wholly deprived;* and even in such cases this form of decree has received the approval of the courts of last resort in this country and England.

The prohibition here is not an absolute prohibition, preventing any use of the word "Remington." It prohibits its use only "as the *name* or part of the *name* of any typewriting machine" made by the defendant and forbids selling typewriting machines made by the defendant "under the *name* of or as Remington-Sholes or of any *designation* of which the word Remington shall constitute part" (R., pp. 1503–04).

It will be observed that the decree does not prohibit the defendant from stating that Mr. Franklin Remington is a stockholder or is interested in the machine, or any other fact. It simply prohibits the use of "Remington" or its equivalent as a name.

If the injunction had prohibited the use of the word absolutely, and not simply as a name or designation, there

might be some foundation for the comments of our friends on the other side. It prohibits only what the facts show it is impossible for the defendant to do without causing mistake, confusion, and fraudulent substitution. It is the use of the word "Remington" as a name or part of the name of another business and another machine which necessarily results in defrauding the complainant and deceiving the public. No addition or qualification could, as a matter of fact, correct the wrong, and the courts below properly followed that form which experience has shown is alone sufficient to give effect to the settled rule of law.

The same form of decree was issued and commented upon by the Court of Appeals for the Eighth Circuit, in Shaver *v.* Heller, 108 Fed. 821, 824–5; by the House of Lords in Montgomery *v.* Thompson, A. C. (1891) 217, and in many other cases. (See principal brief, p. 278.)

The decree in the case of Royal Baking Powder Co. *v.* Royal, to which the defendant directed attention at the argument, was broader and more sweeping than the decree in this case, and that was a case where the defendant had a right to use his name of which he could not be deprived. The defendant was not using his name in that case directly as a name or part of the name of the product, which was called "Maxim Baking Powder." The Court of Appeals did more than prevent his using it as a name. It prescribed that if he used it at all it must be "in the least conspicuous manner possible consistent with the right" to use it. (122 Fed. 337–348.)

The suggestion that the decree in the case of Singer Manufacturing Co. *v.* June (163 U. S. 202) is instructive, is, we venture to think, obviously a misconception. In that case, by reason of the existence of patents which covered the machine, the name "Singer" had come to indicate to the public the particular *kind* of machine covered

by the patents. It followed that everyone had the right to use the name "Singer" "to its fullest extent;" in other words, as the *name* of that *kind* of machine, because the name "Singer" indicated not the origin but the kind of machine. And from this, in turn, it followed that accompanied by a statement that a company of another distinctive name was the maker, the name "Singer" would convey no misrepresentation.

In the present instance the name "Remington" does not and never has indicated a kind of machine, but only origin from the business now owned by the complainant. "Singer," in other words, meant "this is a machine made in accordance with certain patents." "Remington" means "this machine embodies the good workmanship which prevails only in the business now owned by the complainant." No one could be deprived of the right to use the first name or the equivalent expression. No one (except, perhaps, a person born to the name) but the complainant can truthfully use the second name, or its equivalent expression.

In brief, the decree in this case is not more broad than the form of decree which is sanctioned in relevant cases where the defendant has used a word which it had a right to use as a *word*, but because as a name it had come to be a "trade denomination" could not truthfully use as a *name*. It is less broad than the form of injunction usually issued in cases where the defendant has no *right* to use the word in any form, and if anything, less broad than that to which the complainant was entitled.

The decree and result being in exact accordance with all the relevant authorities, it remains to consider the more important errors in the argument by which it is sought to be overthrown. We respectfully submit that this argument involves an important error of law and several fatal fallacies.

What we venture to conceive is the error in law involved in the argument, is that it confuses the rules applicable to cases wherein a man uses his own name in his own business and where some use is consequently matter of necessity and the injury may be *damnum absque injuria*, with cases where a corporation beginning a new business, as this constructive defendant was when the name was first used, selects a name embodying the good-will of an established rival in the same industry where any use of the name is pure matter of choice and any confusion (which is necessarily harmful to the rival, the public and the new-comer, if it has any desire to build up a reputation and good-will of its own) is wholly unnecessary and therefore inequitable.

The case is not one where a corporation takes over from an individual an established business and good-will and the name which identifies to the public that business. It is a case where a corporation is formed to inaugurate a new business and selects for it a name under which to begin to introduce itself and the origin of its goods to the public.

It may be important to observe that the argument on behalf of the defendant obscures the fact that not until the corporation bearing the name Remington-Sholes was organized was any business transacted or any machine sold or offered for sale. The corporation took over no business or good-will whatever. It was, in so far as the manufacture and sale of typewiters for the public were concerned, an entirely new enterprise, and it had the entire universe from which to select a name.

Mr. Remington made an investment. He made or sold no typewriter. The distinction is important because while a surname which has ceased to indicate to the public a man's personality and come to indicate his business may be transferred with that business, a surname which indicates to the public only a man's personality is in the

nature of things incapable of being transferred to another so that the transferee will derive any rights from the transfer.

This is the decision of this Court in Manhattan Medicine Company *v.* Wood (108 U. S. 218) wherein it was held that the use by a transferee of the name of its transferor which still indicated his personality and had not been so widely used as to indicate to the public his business (as distinguished from his personality) was a fraud or misrepresentation which conferred no rights which a court would recognize.

It is suggested that Mr. Remington's name was "property" and that the corporation desired to use this property. There are various kinds of property and what is true of one kind is not necessarily true of another. Of all species of property that which most closely resembles a man's surname is a technical trade-mark. Both are symbols of individuality and identification which belong and are appurtenant to the thing which they identify. A technical trade-mark cannot be divorced from or transferred apart from the good-will of the business in which it has acquired its meaning, and a man's name which has identified only his personality cannot be divorced therefrom and used to identify another. Such transfers simply amount to permission to practice misrepresentation or false personation and have no foundation in reason or law.

Rendle *v.* Rendle & Co., 63 L. T. N. S. 94.

Sawyer *v.* Kellogg, 7 Fed. 720.

Morrall *v.* Hessin, 19 R. P. C. 557; 20 R. P. C. 429.

The question in this case is not whether Mr. Remington had invested money but whether before the corporation was formed he had built up such a business that to the public his name had ceased to indicate his personality and come to indicate his business. Upon that question there

is no room for difference of opinion. Mr. Remington had no business whatever. He had made or sold no typewriter. The public had no possible intimation of any "Remington" business except that of the complainant. He could not, therefore, confer on another any right whatever to use the name, and the rights of the constructive defendant are precisely the same as if no one named Remington were connected with it.

In this case, therefore, "we have no occasion to deal with the long line of authorities, touching the ordinary inherent right of every person to the honest use of his own surname." These have not "been extended to corporations which have appropriated surnames for use in connection with proprietary articles; while they uphold with a firm hand the fundamental doctrines of honesty and good faith as applied to this branch of the law, and have been vigilant in searching out and punishing evasions and artifices, even in connection with this primitive right" (Le Page *v.* Russia Co., 51 Fed. 941, 943–4).

Valentine Meat Juice Co. *v.* Valentine Extract Co., 17 R. P. C. 693;

Charles S. Higgins Co. *v.* Higgins Soap Co., 144 N. Y. 462;

DeLong *v.* DeLong Hook & Eye Co., 32 N. Y. Supp. 203;

Garrett *v.* T. H. Garrett & Co., 78 Fed. 472;

Rogers Mfg. Co., *v.* Rogers & Spurr Mfg. Co. 11 Fed. 495;

William Rogers Mfg. Co. *v.* R. W. Rogers Co., 66 Fed. 56; 70 Fed. 1017;

International Silver Co. *v.* Rogers Co., 110 Fed. 955;

Bissell Chilled Plow Works *v.* T. M. Bissell Plow Co., 121 Fed. 357, and cases cited;

Tussaud *v.* Tussaud 44 Ch. Div. 678.

There is not one authority to the contrary.

The reasons for the choice by the defendant of the name "Remington" were obviously those set forth in the opinion of the court below. (R., p. 1528.) Even the reason suggested in the dissenting opinion that the name was selected for use in connection with typewriters in order to suggest not "Remington typewriters" but "Remington Fire Arms," amounts to no more than a suggestion that the defendant may have desired to trade upon the goodwill of the Remington Arms Company as well as upon that of the complainant. There is certainly nothing in the record to support this suggestion or to contradict the obvious fact that the word "Remington" was given to the new typewriter venture in order to take advantage of the reputation which typewriters everywhere known as "Remington" had gained. Indeed, the suggestion simply amounts to a confession that the petitioner adopted the name to "steal away" some good-will and property which did not belong to it. We submit that obviously it was our good-will and property that it sought to "steal away," but it is not perhaps very important in so far as preventing the continuance of the wrong is concerned, whether the Rem ington Arms Company may also suffer.

Clark Thread Co. *v.* Armitage, 45 U. S. App. 62, and cases cited.

Besides setting up no legal defense, the argument of the defendant, we venture to think, involves many fallacies which have often been exposed, to which we beg to be permitted to direct attention.

Perhaps all these fallacies may be summed up by saying that the argument is fallacious because it omits from consideration the controlling fact that the designation "Remington" in connection with typewriters at the time the defendant entered the field had acquired a secondary meaning, and was so used and understood the world over, and

seeks to discover whether the defendant's conduct is reasonable by considering its actions as isolated facts divorced from this all-important circumstance.

During the defendant's argument in the case of Reddaway *v.* Banham (A. C. 1896, 214), the Lord Chancellor pointed out the fallacy underlying such an argument in the following words:

> "I do not see any difficulty at all. *There is no inherent right to say anything at all times and to all people under all circumstances.* What you must look at is the people to whom it is addressed and the effect it is producing, and if the effect is to make them believe that they are buying something which they are not buying, then that is cheating." (13 R. P. C. 218.)

When the defendant entered the field the designation "Remington" in connection with typewriters had acquired a perfectly definite and secondary meaning as giving notice of the skill, knowledge and probity which prevail in the business now owned by the complainant. There was nothing "more or less" about it. The name had become, in the words of Lord Westbury in the "Glenfield Starch" case, "a trade denomination" (5 H. L. 510), indicating in fact the origin and, therefore, the excellence of the article, to the exclusion of everything else.

This is the finding of both the courts below; and there is no doubt that the finding is abundantly supported by all the evidence in the record, which admits of no other possible conclusion. The testimony on behalf of the complainant is all to the same effect, and the universal understanding of the term "Remington" is made plain by the literature of the defendant. (Pp. 223–229.)

That the name "Remington" in connection with typewriters would suggest or tell nothing to the public concerning Mr. Franklin Remington is, in substance, admitted

by the defendant's counsel, who stated in their brief below that at the time the constructive defendant entered the field "the name Remington was admittedly a by-word for good workmanship the world over."

The designation "Remington" in connection with typewriters has never given notice of the judgment, skill and probity of any *individual*, but always of that prevailing in a business and establishment owned by a corporation.

When used by the corporation E. Remington & Sons, the designation "Remington" gave notice of the painstaking industry embodied in the typewriters produced by the organization and in the business owned, not by any individual but by the corporation. The value of the name depended not on individual effort but on the combined result of all which many individuals had created. And every particle of that value was the property not of any individual but of the corporation.

LePage *v.* Russia Cement Co., 51 Fed. 941;
Clark Thread Co. *v.* Armitage, 74 Fed. 936:
Walter Baker & Co. *v.* Saunders, 80 Fed. 889;
Kidd *v.* Johnson, 100 U. S. 617–620;
Richmond *v.* Richmond Nervine Co., 159 U. S. 293;
Feder *v.* Benkert, 70 Fed. 613.

And when the complainant acquired the business and establishment in which the typewriters were produced, the designation "Remington" continued to give notice that the typewriters in connection with which it was used embodied the skill, knowledge and probity peculiar to that business and establishment, and as the business expanded the designation "Remington" in connection with typewriters came to have everywhere and to everyone, here and abroad, this definite, secondary meaning of origin and, therefore, excellence, to the exclusion of everything else.

Any consideration of the situation existing at the time when the constructive defendant entered the market, therefore, begins with the controlling fact that at that time the designation "Remington" as a matter of fact effectually guaranteed that the typewriter in connection with which it was used embodied the particular skill, knowledge and probity which prevail only in the establishment and business owned by the complainant.

Here, then, we respectfully submit, is one fatal fallacy in the defendant's argument. It omits the fact that by using the designation "Remington" in connection with its machine the constructive defendant was not, as a matter of fact, informing the public concerning any of the incidents which the argument assumes might interest the public, but (because persons understand by "Remington" in connection with a typewriter that it originated in the business owned by the complainant) it is representing that its goods are made by the complainant.

In Elgin National Watch Co. *v.* Illinois Watch Co., this court, quoting the words of Lord Herschell in Reddaway *v.* Banham (A. C. 1896, 199) said:

> "I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used to persons in the trade who will understand it, and be known and intended to understand it in its secondary sense, it will none the less be a falsehood that in its primary sense it may be true." (179 U. S. 665–676.)

In the present instance we are not complaining of a statement in a catalogue or elsewhere to the effect that a machine of an honest name, marketed by a company of an honest name, is sold with the approval or embodies in part an investment of a son of a stockholder and officer of a

corporation which formerly owned our business. If the constructive defendant, calling itself The Fay-Sholes Company and its typewriter the Fay-Sholes typewriter (as it now does) chooses honestly to make such a statement, it may do so without the slightest embarrassment from the injunction which has been issued or an injunction which restrains the misleading abbreviation as well as the misleading name it abbreviates. It is not the use of the name "Remington" in a statement concerning the life and works of Franklin Remington and his connection with the defendant's business of which we complain and no such use is affected by the injunction.

If it is suggested that the use of the designation "Remington" as used by the constructive defendant is equivalent to such a statement, we respectfully answer that the record conclusively shows, and as pointed out by the court below the defendant's counsel in effect admit that the use of the word "Remington" in connection with a typewriter does not and cannot convey to the public any information or impression whatever concerning Mr. Franklin Remington, but only the representation that the "good workmanship" which prevails in the business now owned by the complainant for which the "name Remington was admittedly a by-word * * * the world over," is embodied in the machine.

The defendant's argument assumes that the exact status of affairs, the existence of Mr. Franklin Remington, his relationship to an officer and stockholder of the old Remington corporation, his connection as stockholder with the constructive defendant, etc., is known to the public, and that in the name "Remington" when used in connection with a typewriter the public is reminded of all this. On such an assumption there would be no marks of origin and no rules of law relating thereto. The fallacy here lies in

overlooking the fundamental consideration that, in words used in the House of Lords in a very similar case:

> "When you are dealing with the question of people being deceived, that negatives the idea of their having certain knowledge or else they could not be deceived." (North Cheshire Co. *v.* Brewing Co., A. C. 1899, 83.)

Many (and so, constructively, all) purchasers of typewriters, actual or prospective, here and abroad, remember or know nothing whatever concerning the machine which they seek except the guarantee implied in the name "Remington."

This, indeed, is the purpose and result of the use of every trade designation or mark of origin and the foundation of every good-will connected with the sale of widely distributed commodities. When the defendant entered the field, the complainant, by years of painstaking care in manufacture, and enormous expenditure, had put the concept "Remington" into men's minds, and thus created a good-will and favor connected with the business of making and selling typewriters. The public have been educated to recognize the designation by advertisements, by word of mouth, and in many other ways. Necessarily many knew nothing concerning the typewriters except that they had seen or heard and remembered the name and knew that it stood for the care and honesty of a particular manufacture. From this there had resulted a probability which included the whole world that persons desiring a typewriter would look for and be attracted by the name "Remington," and discriminate in favor of typewriters with which that name might be connected. This "probability * * * connected with the name" was the complainant's good-will and property. (Menendez *v.* Holt, 128 U. S. 514.)

The name "Remington" being what the customers and prospective customers looked for and all that they remembered or cared about, "the Remington-Sholes Typewriter Company widely advertised its machines as the Remington-Sholes typewriter" (petitioner's brief, p. 8), "which became known throughout this country and abroad as the Remington-Sholes." (*Ib.* 49.)

The necessary result has been and would (except for the intervention of the court) increasingly be mistake, confusion and fraudulent substitution. And this is sufficiently demonstrated and suggested in the record.

Weingart and Stallwood, seeing the name "Remington," understood it exactly as the constructive defendant understood it when it issued its pamphlet speaking of "Remington," "Remington machine," "Remington bar," etc. Concerning these witnesses, the petitioner's brief says, "they may have been mistaken" (145). Weingart certainly purchased one of the defendant's machines, believing he was purchasing a machine of the complainant's manufacture. The comments of the defendant's counsel on this evidence suggests the remarks of an English judge in a somewhat similar case:

> "The question, therefore, which I have to consider is whether these two * * * are sufficiently similar to deceive. * * * That is the question which I have to decide. There is no evidence of any deception; and, naturally, in this case, as in all others that ever I heard of, stress has been laid upon that. I think, sometimes, in urging that point, counsel forget that *if one case of actual deception is proved there is no more to be said on either side. The case is at an end.* Argument really only takes place where there is no proved case of actual deception." (13 R. P. C., Liebig Company *v.* Chemists' Company, 635–644.)

It is suggested that these purchasers did not exercise "reasonable care" (petitioner's brief, p. 18), the sugges-

tion being that because these purchasers were guilty of something in the nature of contributory negligence, the fact that they actually mistook the defendant's machine for a "Remington" and the manufacture of the complainant is unimportant. But it is to be observed that there is here no question of contributory negligence or "reasonable care" as the words are used in that connection. The care which purchasers ordinarily exercise does not involve a consideration of what they *should* do but what, as a matter of fact, they *do;* and there could be no better proof of this than the testimony showing what they actually did. The petitioner relies upon the case of Rogers *v.* Simpson (54 Conn. 568) as stating the rule. But in that case the court points out the fallacy of confusing the ordinary care of the unsuspecting customer with the reasonable care required from a plaintiff, saying:

> "The fact that careful buyers * * * are not deceived does not materially affect the question. It only shows that the injury is less—not that there is no injury. Another class of purchasers to whom large quantities are sold are deceived. Such purchasers perhaps will have no reason to complain as they, if they are injured by the deception, must attribute the injury to their own want of diligence. But the petitioners stand on entirely different ground. No amount of diligence on their part will guard against the injury. An injunction is their only adequate remedy, and to that we think they are entitled."

Prudent and thrifty people and those knowing and remembering distinctly all the details concerning the article they seek and its manufacturer take care of themselves. It is the ordinary lack of precise information or recollection of the ordinary unsuspecting customer which it is important to consider in the endeavor to check unfair competi-

tion and protect and encourage enterprise and excellence in the production of distributed commodities.

Wotherspoon *v.* Currie, 5 H. L. 510;
Celluloid Co. *v.* Cellonite Co., 32 Fed. 94;
Singer Co. *v.* Loog, 8 App. Cases, 18;
Powell *v.* Birmingham, &c., Co., L. R. Ch. (1896) 68;
McLean *v.* Fleming, 96 U. S. 242;
Amoskeag Co. *v.* Spear, 2 Sand., S. C., 599;
N. K. Fairbank Co. *v.* Luckel, Cake, &c., Co., 102 Fed. 327;
Saxlehner *v.* Eisner, 179 U. S. 19.

In the present instance ordinary purchasers using the ordinary care which, as a matter of fact, purchasers do exercise understood the designation "Remington" as used by the defendant just as the defendant in its instructions to salesmen shows it understood it, to wit, as indicating origin from the complainant; and their custom was by this false representation diverted.

In brief, the representation with which the Court is called on to deal is not in fact a representation that Mr. Franklin Remington or his brother is represented in the new company, and the whole of the defendant's argument which is addressed to justifying such a representation is, as we respectfully submit, without applicability or value in the present case. The representation which is in fact made is a misrepresentation as to the origin of the new article, the continuance of which admits of no possible justification.

It is to no purpose to argue that because in the abstract a man may join others in incorporating a company and because the public may be interested in genealogy and because there is no room in the world for sentiment as well as honesty, or because of other things which the defendant's argument suggests, it follows that this defendant may in

fact say to such purchasers of its machines: "This typewriter is the latest product of that 'good workmanship' for which 'the name Remington is a by-word * * * the world over,'" and which is bestowed on typewriters only in the business and establishment owned by the complainant and thus by misrepresentation or fraud impose upon the public and cheat the complainant out of the results of years of painstaking industry and enormous expenditures. And because the word "Remington" in connection with typewriters had in fact acquired a secondary meaning and was so used and understood, it is such a representation with such a result that the defendant in fact makes when it uses the designation.

This is the misrepresentation or fraud of which we complain—the misrepresentation of the origin of the machine by the use of the name which in fact indicates that it is a product of our own business and symbolizes our reputation and good-will. The appearance or construction of the machine of which the ordinary purchaser is not aware and which is not in any way affected by the decree—is not material.

It is impossible for two typewriters to be as different as were the articles involved in the Valentine case, to which attention has been directed. And the differences could not have been more urgently brought to the attention of the Court. Referring to this point, Lord Justice Collins said:

> "The get-up has nothing whatever to do with this case. It may be dismissed altogether from the discussion because the representation is not as to the form in which the thing is sold."

Said Lord Justice Rigby:

> "They wanted * * * not to take so much advantage of the resemblance of the product but, on the

suggested resemblance, of the origin. And I think it is unnecessary to go farther than that." (17 R. P. C. 686.)

In the present instance the representation is that the new machine is a "Remington"—a machine from the origin that name is understood to indicate embodying the excellence that name is understood to guarantee. What kind or variety of machine—whether improved or having some modifications made by one Sholes or what not—is immaterial.*

*Among other cases which emphasize the fact that where the symbol which embodies a good-will consists of a name the appearance or "get-up" of the article is of practically no value in preventing the evil which the law aims to correct are:

Wotherspoon *v.* Currie, L. R., 5 H. L., 510;
Read *v.* Richardson, 45 L. T., N. S., 54;
N. K. Fairbank Co. *v.* Luckel, &c., Co., 88 Fed. 695; 102 Fed. 331;
Cochran *v.* MacNish, A. C., 1896, 225;
Johnson & Johnson *v.* Bauer & Black, 79 Fed 954; 82 Fed. 662;
Saxlehner *v.* Apollinaris Co., 13 T. L. R. 258;
Hiers *v.* Abraham, 82 N. Y. 521;
Shaver *v.* Heller & Merz Co., 108 Fed. 821;
Thompson *v.* Montgomery, 41 Ch. D. 35; 138 U. S. 550;
Selchow *v.* Baker, 93 N. Y. 59;
Morse *v.* Worrell, 10 Phil. 168;
Reddaway *v.* Banham, H. L. App. C. (1896), 214;
Apollinaris Co. *v.* Norrish, 33 L. T., N. S., 242;
N. K. Fairbank Co. *v.* Central Lard Co., 64 Fed. 134;
Seixo *v.* Provezende, L. R., 1 Ch. 192;
Congress, &c., Co. *v.* High Rock Congress Spring Co., 54 N. Y. 291;
Anheuser-Busch Brewing Association *v.* Piza, 24 Fed. 149;
Colgate *v.* Adams, 88 Fed. 899;
Clark Thread Co. *v.* Armitage, 74 Fed. 936;
Higgins Soap Co. *v.* C. S. Higgins & Co., 144 N. Y. 462;
Royal Baking Powder Co. *v.* Raymond, 85 Fed. 231;
Enoch Morgan's Sons Co. *v.* Wendover, 43 *Ib.* 420;
Metzler *v.* Wood, 8 Ch. D. 606;
City of Carlsbad *v.* Kutnow, 71 Fed. 168;
Fuller *v.* Huff, 105 Fed. 141.

Among other cases which emphasize the fact that a qualifying word by way of prefix or suffix to a designation which embodies a good-will should be disregarded are those involving:

And there is no doubt whatever that as a matter of fact the use of the designation "Remington" has resulted in misconception as to the origin of the respondent's machines. The record contains various instances showing confusion, which have already been examined in our principal brief. For present purposes it is sufficient to direct attention to the fact that the defendant itself admits in its literature that "the question is often asked, what connection has the Remington–Sholes Company with the Remington Standard Typewriter?" There could hardly be a plainer confession that persons have understood the representation conveyed by the name "Remington" as (having regard to the secondary meaning of the word) it would

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"Queen" and "Queen Quality," 105 Fed. 377;
"Congress" and "High Rock Congress," 54 N. Y. 291;
"Carlsbad" and "Kutnow's Improved Effervescing Carlsbad," 71 Fed. 168;
"Home" and "Home Delight," 59 Fed. 284;
"Apollinaris" and "London Apollinaris," 33 L. T. R. 242;
"Glenfield" and "Royal Palace Glenfield," 5 H. L. 508;
"Budweiser" and "Milwaukee Budweiser," 87 Fed. 864;
'Sunlight" and "American Sunlight," 88 Fed. 485;
"Royal" and Royal London," 76 Fed. 465;
"Health Food" and "Sanitarium Health Food," 104 Fed. 141;
"Comfort" and Home Comfort," 127 Fed. 962;
"Sanitas" and "Condi-Sanitas," 56 L. T., N. S., 621 (4 R. P. C. 195);
"Portland" and "Famous Portland," 52 N. J. Eq. 380 (28 Atl. Rep. 788);
"Roy Watch Case Co." and "Camm-Roy Watch Case Co., 59 N. Y. Supplement, 979;
"Star" and "Lone Star," 51 Fed. 832;
"Cashmere" and "Violets of Cashmere," 88 Fed. 899;
'Hohner" and "Improved Hohner," 52 Fed. 871;
'Pride" and "Pride of Syracuse," 82 N. Y. 519;
"German Household Dyes" and "Excellent German Household Dye" 94 Wis. 583 (69 N. W. Rep. 569);
"Guinea Coal Co." and Pall Mall Guinea Coal Co.," 5 Ch. 155;
"Le Page's Liquid Glue" and "Le Page's Improved Liquid Glue," 147 Mass. 206;
'The American Grocer" and "The Grocer," 25 Hun, N. Y. 398.

naturally be understood and as, no doubt, it was intended to be understood, to wit, as indicating that the new machine was a product of the complainant's business.

But the defendant argues that it always took pains to correct such erroneous impressions. The situation here again is the same as in the Valentine case, where Lord Alverstone said:

> "That is answered by the defendants by saying, whenever that came to our knowledge we did our best to put it right. We said, 'We have nothing to do with the Valentine Meat Juice Company.' The answer is that, of course they did so; and if any letter of the kind has been found in which they had stated that they were connected with the Valentine Meat Juice Company, the fraud of course would have been conclusively established; but we have not got to consider what was the explanation given to the persons who asked for an explanation and got it. * * * We do not know, of course, how many other people who did not write for an explanation would have remained under the same inpression" (17 R. P. C. 682).

Lord Justice Rigby pointed out that it was incumbent upon the new-comer in the market to be

> "careful, not to counteract the necessary results of what they did, but not to do that which necessarily led them to a result of that kind" (p. 686).

The necessary effect of the use which the defendant makes of the designation "Remington" is very clearly shown by the testimony concerning the acts of the middlemen who market its machines, particularly abroad. The misleading and hurtful nature of the representations made by these middle-men is apparent on the face of the advertisements they have issued, and it was admitted by defendant's counsel in argument that they were fraudulent.

That such advertisements and the dealings which they suggest are an obvious and necessary consequence of the defendant's use of the name "Remington" is obvious.

The constructive defendant urges that for these acts it is in no way responsible.

What we understand to be the rule is thus stated by the Supreme Court of Massachusetts:

> "It is found that the defendant did not intend to deceive the public by passing off their goods for the plaintiff's, but this must be taken pretty strictly. They knew that they were putting the power to do so in the retail dealers' hands. It hardly can be doubted that they contemplated that the wholesale dealer at whose request they put up their awls in this form, with full knowledge of the plaintiff's prior use, would or might try to deceive the public, and whether they did or not is immaterial" (N. E. Awl, &c., Co., *v.* Marlborough, &c., Co., 168 Mass. 154).

In the Yorkshire Relish case, it is said:

> "It is argued that the defendant has nothing to do with the deception of the public. The answer is obvious. Every person who, intending to buy a bottle of the plaintiff's sauce, gets instead a bottle of the defendant's, is a customer taken from the plaintiff by this deceit. And if this is extensively done the damage to the plaintiff's trade would be serious" (Powell *v.* Birmingham Vinegar Co., L. R. 1896, Ch. D. 88).

It was said in the House of Lords:

> "It has been long ago pointed out in decided cases that it is not upon a *mala mens* towards the first purchaser that the decision of these cases rests. The first purchaser buys the goods cheaper for the very purpose of being able to sell them as 'Glenfield' starch, the means of doing so being put in his hands by his being furnished with goods with this label—I will not say in order that he may deceive, but it is a

> necessary consequence that he is enabled to deceive others by this means. * * * That is just the very case of all others in which the Court has constantly interfered to prevent that which is a distinct fraud" (Wotherspoon *v.* Currie, 5 H. L., 510).

There are a few expressions in opinions relating to cases wherein the "first purchaser" has fraudulently substituted without any aid from the thing put into his hands by the defendant to the effect that the defendant is not responsible for such frauds. And these expressions have been carefully collected in the petitioner's brief. But there is, we submit, no doubt that the reasoning which takes account of the facts as they actually exist and which corrects instead of encouraging fraud is endorsed and applied in the great majority of well-considered cases.

Reddaway *v.* Banham, A. C. 1896, 200;
LePage *v.* Russia Cement Co., 51 Fed. 941;
N. K. Fairbank Co. *v.* Bell Co., 45 U. S. App. 205;
Garrett *v.* T. H. Garrett, 98 Fed. 473;
Pillsbury *v.* Pillsbury, &c., Co., 64 Fed. 841;
N. K. Fairbank Co. *v.* Luckel, Cake, &c., Co., 102 Fed. 331.
Von Mumm *v.* Frash, 56 Fed. 830;
Hostetter *v.* Sommers, 84 Fed. 303;
Saxlehner *v.* Apollinaris Co., 13 T. L. R. 258;
Ewing *v.* Johnson, 18 Ch. D. 612;
Lever *v.* Goodwin, 36 C. H. D. 1;
Little *v.* Kellam, 100 Fed. 353;
Hostetter *v.* Becker, 73 Fed. 297;
Collinsplatt *v.* Finlayson, 88 Fed. 693;
National Biscuit Co. *v.* Baker, 95 Fed. 135.

The fact that the machines are sold to middlemen with consciences of varying elasticity throughout the world and pass from hand to hand unaccompanied by the many facts

upon which the defendant relies is, in short, an important circumstance to be considered in judging the character of the representation which the defendant is making. And the acts of these distributors demonstrate the accuracy of the conclusion which necessarily followed from the fact that the name "Remington" had acquired a secondary meaning, that by the use of the name the goods of the defendant are in fact represented as the goods of somebody else.

The Courts below, in substance, simply found this fact and simply applied the rule endorsed by this Court and the House of Lords, that "No one has a right to represent his goods as the goods of somebody else."

And in applying this the Courts below simply recognized that any use of "Remington" as a name or part of the name of defendant or its product would amount to such a representation and that the defendant had no right (as a man using his own name in his own business might have) which the decree would impair, and following the unanimous voice of authority under the common law issued an injunction in the form which has received the approval of every court here and in England before which such a case has come.

See *e. g.* Valentine *v.* Valentine, 17 R. P. C. 673, 688, and cases cited *supra*, pp. 4–6.

There are several suggestions in the petitioner's brief to the effect that two men may use their names as a partnership name and that, therefore, they may transfer their names without any business or good-will to a corporation. The premise of this argument is one which, like the proposition that a man may use his own name in his own business, is not before the Court. The discussion of it would require quite as much time and space as has been devoted to the case which is before the Court. It is possible that in a certain case the use of two names in a firm-name might give notice that two persons were in fact engaged

in the business, and if so there would be no objection to their use. In another case the use of the names might in fact amount to a false representation, and in such a case the Court would not hesitate to correct it. To borrow the recent words of an English Judge:

> "Croft *v.* Day, in 7 Beavan, page 84, is an illustration of this, where a real Day and a real Martin were restrained from trading under the name of Day & Martin as makers of blacking because it was a manufacture of the well-known firm of Day & Martin, the reason for the injunction being that the name of Day & Martin had been adopted for the purpose of representing and holding out to the public that it was the old firm of Day & Martin" (Morrall *v.* Hessin, 19 R. P. C. 557–564).

There is no occasion to consider what might have been the result had Mr. Franklin Remington and Mr. Sholes formed a partnership. Perhaps had they done so the business might have been regarded as their business. And it is quite impossible to consider the question because the facts as to what they would have done and how they would have used the name, which would be of controlling importance in a case which necessarily depends on questions of fact, have never been developed.

The case at bar is far less difficult of solution because it is a case where a corporation with no name and no business unnecessarily selects the name which in fact embodies another's good-will with the purpose and result of fraudulently stealing away the fruits of that other's labor and cheating the public into taking its unknown product by a representation which in fact conveys a falsehood.

Under the unbroken line of authority which promotes competition by insuring the free and unconfused choice of the public between different makes of the same thing without which legitimate competition is impossible, which

encourages industry and excellence by insuring adequate reward and which, while promoting commercial integrity, prevents imposition on the public, there can, we respectfully submit, be no other solution than that reached by both courts below.

The designation "Rem.-Sho." is simply an abbreviation of the name Remington-Sholes, and it is used by the petitioner as an abbreviation, with periods indicating that it is an abbreviation, in most of its literature.

"Rem." was used as an abbreviation for "Remington" in connection with the complainant's machine for many years before the defendant used it, and it has been used by the defendant in connection with its name so that to everyone it has meant "Remington" just as it did before the petitioner was ever heard of.

It was said by the learned Judge in the Court of first instance:

> "The long name 'Remington-Sholes' got shortened into 'Rem.-Sho.' in writing and speech in conducting the defendant's business, which was well understood to be an abbreviation of the full name. * * * If this short name had been the first one used, there would be much plausibility in this argument, but following 'Remington-Sholes' as it has in use, it has become a well-known, short representation of what the long name it stands for represented and of itself now amounts to a wrongful representation of the source of the defendant's machines."

We respectfully submit that, under such circumstances at least, an abbreviation which is tantamount to a certain word is equivalent in law to the word for which it stands.

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